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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Attorney Docket No. 6791.40 (1001-0781)

Application of: **Peters**

Group Art Unit: **2681**

Serial No. **09/303,360**

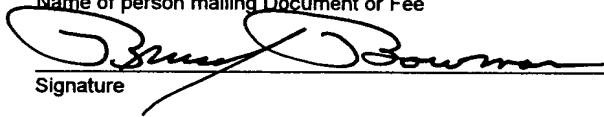
Examiner: **C.Craver**

Filed: **April 29, 1999**

Title: **Interactive Phone System Utilizing Wireless Channels**

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LETTER

Asst. Commissioner of Patents
Washington, D.C. 20231

Sir:

Enclosed are an original and three (3) copies of an Appeal Brief in connection with the above-identified patent application. The Notice of Appeal was filed on April 2, 2002, the Appeal Brief was due two months from this date (i.e. 06/02/02). Also enclosed herewith is a check for \$320.00 to cover the fee required under 37 CFR 1.17(c).

Additionally, the U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency or credit any overpayment, to our Deposit Account No. 13-0014, but not to include any payment of issue fees. If extensions of time under 37 C.F.R. § 1.136 are required to prevent abandonment of the present patent application, then such extensions of time are hereby petitioned for, and any fees therefor are hereby authorized to be charged to our Deposit Account No. 13-0014.

April 30, 2002

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Attorney Docket No. 6791.40 (1001-0781)

Application of: Daniel V. Peters

Group Art Unit: 2681

Serial No.: 09/303,360

Examiner: C. Craver

Filed: April 29, 1999

For: **Interactive Phone System Utilizing Wireless Channels**

BRIEF ON APPEAL

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

This is an appeal under 37 CFR § 1.191 to the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office from the final rejection of the claims 1-10 and 12-17 of the above-identified patent application. These claims were indicated as finally rejected in an Office Action mailed January 3, 2002. Three copies of the present Appeal Brief are filed herewith, together with the \$320.00 fee required under 37 CFR § 1.17(c). Also, please provide any extension of time that may be necessary and charge any fees that may be due to Account No. 13-0014, but not to include any payment of issue fees.

(1) REAL PARTY IN INTEREST

NCR of Dayton, Ohio is the assignee of this patent application, and the real party in interest.

(2) RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences related to this patent application (serial no. 09/303,360).

(3) STATUS OF CLAIMS

Claims 1-17 are pending in the application.

Claims 1-10 and 12-17 are rejected.

Claim 11 is objected to.

Claims 1-10 and 12-17 are being appealed.

Each of claims 1-10 and 12-17 is provided in an Appendix attached to this Appeal Brief.

(4) STATUS OF AMENDMENTS

Appellants have filed no amendments subsequent to the final rejection contained in the Office Action mailed January 3, 2002.

(5) SUMMARY OF INVENTION

Appellants' invention is an interactive telephone system that utilizes a wireless channel to provide a telephony feature. The telephone system includes a phone system controller and a telephone system interface. The phone system controller is coupled to a telephone line. The telephone system interface is coupled between a telephone handset and the telephone line. The telephone system interface is operative to selectively couple the telephone handset to the telephone line, and also to establish a wireless control channel to the phone system controller. The wireless control channel is operative to carry the control signals associated with the telephony feature between the telephone system interface and the phone system controller.

(6) ISSUES

Whether claims 7, 8 and 12-17 are unpatentable under 35 U.S.C. §102(b) as being anticipated by Bendixen et al. (U.S. Patent 4,890,315).

Whether claims 1-6 are unpatentable under 35 U.S.C. §103(a) as being obvious over Bendixen et al. (U.S. Patent 4,890,315).

Whether claim 9 is unpatentable under 35 U.S.C. §103(a) as being obvious over Bendixen et al. (U.S. Patent 4,890,315) in view of Armstrong et al. (U.S. Patent 5,339,352).

Whether claim 10 is unpatentable under 35 U.S.C. §103(a) as being obvious over Bendixen et al. (U.S. Patent 4,890,315).

(7) GROUPING OF CLAIMS

Claims 7, 8 and 12-17 form a first separately patentable group that is argued independently of the other claims for purposes of this appeal.

Claims 1-6 form a second separately patentable group that is argued independently of the other claims for purposes of this appeal.

Claim 9 forms a third separately patentable group that is argued independently of the other claims for purposes of this appeal.

Claim 10 forms a fourth separately patentable group that is argued independently of the other claims for purposes of this appeal.

(8) ARGUMENT

I. 35 U.S.C. § 102(b) Rejection of Claims 7-8 and 12-17 (Bendixen et al.)

Claims 7-8 and 12-17 were rejected under 35 U.S.C. §102(b) as being unpatentable over U.S. Patent No. 4,890,315 issued to Bendixen et al. (hereinafter referred to as "Bendixen"). Reconsideration of claims 7-8 and 12-17 is respectfully requested.

A. First Claim Grouping: Claims 7-8 and 12-17

Discussion re: Patentability of Claim 7

1. *Claim 7*

Independent Claim 7 recites:

7. A telephone system for providing a telephony feature, comprising a phone system controller and a first telephone system interface, wherein:

 said first telephone system interface is coupled between a first telephone handset and a telephone line, said first telephone system interface operable to (i) selectively couple said first telephone handset to said telephone line, and (ii) establish a first wireless control channel to said phone system controller,

 said wireless control channel operable to carry control signals associated with said telephony feature between said first telephone system and said phone system controller, and

 said phone system controller is coupled to said telephone line and operable to (i) receive said first control signals via said wireless control channel, and (ii) process said first control signals to provide said telephony feature.

2. Bendixen Does Not Anticipate Claim 7

Independent claim 7 recites a telephone system that provides a telephony feature comprising a phone system controller and a first telephone system interface. The first telephone system interface is coupled between a first telephone handset and a telephone line. The phone system controller is coupled to the telephone line. The first telephone system interface and the phone system controller are thus both coupled to the telephone line. A wireless control channel is operable to carry control signals between the first telephone system interface and the phone system controller.

The Examiner has indicated that the "network" of Bendixen reads on the phone system controller recited in claim 7, while the telephone line of claim 7 is shown in Bendixen as "J3." Applicant respectfully disagrees that the "network" of Bendixen is a phone system controller and/or reads on the phone system controller as presently claimed. The Bendixen "network" is by Bendixen's specification admittedly *remote* from Bendixen's control unit. The "network" is accessible only via radio frequency communication. Further, the Bendixen

"network" does not function in the same manner as the present phone system controller. The limitations of claim 7 require that the phone system controller be coupled to the same telephone line as the telephone system interface. This is not present in Bendixen.

In contrast to the limitations of claim 7, the Bendixen control unit couples one or more telephone handsets with a cellular telephone system. A cellular telephone system is not a phone system controller as presently claimed or as described in the present specification. Nowhere in Bendixen is there a teaching that the cellular telephone system performs in the same manner as the present phone system controller.

3. Conclusion

"For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be identically shown in a single reference" In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). As shown above, Bendixen does not show and/or teach each and every limitation of independent claim 7. Therefore, Bendixen cannot anticipate claim 7.

Since the Bendixen does not teach every limitation of claim 7, a *prima facie* case of anticipation under 35 U.S.C. § 102 has not been established with regard to the invention of claim 7. Accordingly, withdrawal of the rejection, reconsideration and allowance of Applicant's claim 7 is hereby respectfully requested.

Discussion Re: Patentability of Claims 8 and 12

Claims 8 and 12 include claim 7 as a base claim. As a result, claims 8 and 12 are allowable for the reasons hereinbefore discussed in regard to claim 7. Moreover, claims 8 and 12 include further limitations not shown or taught in Bendixen. As a result, claims 8 and 12 are further allowable over the cited art. Indeed, a *prima facie* case of anticipation under 35 U.S.C. §102 has not been established with regard to the invention of claims 8 and 12 since, in addition to the reasons hereinbefore discussed in regard to claim 7, the cited art does not arrive at the limitation of Applicant's claims 8 and 12. Accordingly, withdrawal of the rejection, reconsideration and allowance of Applicant's claims 8 and 12 is hereby respectfully requested.

Discussion re: Patentability of Claim 13

1. Claim 13

Independent claim 13 recites:

A method of connecting a telephone to a phone system controller coupled to a telephone line that provides a telephony feature, comprising the steps of:
establishing a wireless control channel between said phone system controller and a phone system adaptor box coupled to said telephone line and said telephone;
transmitting control signals associated with a telephony feature from said phone system controller to said phone system adaptor box via said wireless control channel; and
processing said control signals at said phone system adaptor box in order to provide said telephony feature.

2. Bendixen Does Not Teach the Limitations of Claim 13

Bendixen does not teach the limitations of independent claim 13. While independent claim 13 is a method claim, the same arguments with respect to the patentability of claim 7 are applicable to the patentability of claim 13.

Specifically, Bendixen does not teach a method of connecting a telephone to a phone system controller coupled to a telephone line that establishes a wireless control channel between the phone system controller and a phone system adapter box that is coupled to the *same* telephone line. Bendixen, in contrast to the limitations of claim 13, sends wireless signals from a control unit that is coupled to a telephone handset to a remote network that is coupled to a *remote land line telephone system*. This is not shown or taught in Bendixen.

"For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be identically shown in a single reference" In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Bendixen cannot anticipate claim 13 since every element of claim 13 is not identically taught in Bendixen.

3. Conclusion

Since Bendixen does not teach the limitations of independent claim 13, a *prima facie* case of anticipation under 35 U.S.C. § 102 has not been established with regard to the invention of claim 13. Accordingly, withdrawal of the rejection, reconsideration and allowance of Applicant's claim 13 is hereby respectfully requested.

Discussion Re: Patentability of Claims 14-17

Claims 14-17 include claim 13 as a base claim. As a result, claims 14-17 are allowable for the reasons hereinbefore discussed in regard to claim 13.

Moreover, claims 14-17 include further limitations not shown or taught in Bendixen. As a result, claims 14-17 are further allowable over the cited art. Indeed, a prima facie case of anticipation under 35 U.S.C. §102 has not been established with regard to the invention of claims 14-17 since, in addition to the reasons hereinbefore discussed in regard to claim 13, the cited art does not arrive at the limitation of Applicant's claims 14-17. Accordingly, withdrawal of the rejection, reconsideration and allowance of Applicants' claims 14-17 is hereby respectfully requested.

II. 35 U.S.C. § 103(a) Rejection of Claims 1-6 (Bendixen et al.)

Claims 1-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,890,315 issued to Bendixen et al. ("Bendixen"). Reconsideration of claims 1-6 is respectfully requested in view of the following.

A. Second Claim Grouping: Claims 1-6

Discussion re: Patentability of Claim 1

1. Claim 1

Independent claim 1, as amended, recites:

A phone system adaptor box for use with a phone system controller coupled to a telephone line that is operable to provide a telephony feature, said phone system adaptor box, comprising:

a switch circuit operable to selectively couple a telephone to said telephone line;
a wireless communication interface operable to establish a wireless control channel between said wireless communication interface and said phone system controller, said wireless control channel operable to carry control signals associated with said telephony feature between said wireless communication interface and said phone system controller; and

a housing operable to house said switch circuit and said wireless communication interface.

2. Bendixen Does Not Render Claim 1 Obvious

The arguments with regard to the patentability of claims 7 and 13 are applicable to the patentability of claim 1. Particularly, Bendixen does not teach or suggest a phone system adaptor box having a wireless communication interface operable to establish a wireless control channel between the wireless communication interface and the phone system controller wherein the phone system controller is on the *same* telephone line as presently claimed. Bendixen, in contrast to the above, provides a cellular remote station having multiple coupled units, the remote station being in contact with a cellular telephone network. This does not teach or suggest that which is recited in independent claim 1.

Further, Bendixen does not teach or suggest that the wireless control channel is operable to carry control signals associated with the telephony feature between the wireless communication interface and the phone system controller as presently claimed. Bendixen teaches a wireless communication channel between a control unit and a *remote* network and/or *remote* land line telephone system. Moreover, Bendixen is providing a solution to interfacing one or multiple telephone handsets via a single source to a cellular telephone system or network. As such, Bendixen offers no suggestion to provide wireless communication between one or multiple telephone handsets within a particular, single line telephone system as does the present invention.

3. Conclusion

In view of the above, a prima facie case of obviousness under 35 U.S.C. § 103 has not been established with regard to the invention of independent claim 1. Accordingly, withdrawal of the rejection, reconsideration and allowance of Applicant's claim 1 is hereby respectfully requested.

Discussion re: Patentability of Claims 2-6

1. Discussion

The discussion regarding the patentability of independent claim 1 is relevant to the patentability of claims 2-6, since claims 2-6 depend from independent claim 1. As a result, claims 2-6 are allowable for the reasons hereinbefore discussed in regard to claim 1.

2. Conclusion

In view of the above, a prima facie case of obviousness under 35 U.S.C. § 103 has not been established with regard to the invention of claims 2-6. Accordingly, withdrawal of the rejection, reconsideration and allowance of Applicant's claims 2-6 is hereby respectfully requested.

III. 35 U.S.C. § 103(a) Rejection of Claim 9 (Bendixen et al. in view of Armstrong et al.)

Claim 9 was rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,890,315 issued to Bendixen et al. ("Bendixen"). Reconsideration of claim 9 is respectfully requested.

A. Third Claim Grouping: Claim 9

Discussion re: Patentability of Claim 9

1. Discussion

Claim 9 is dependent on independent claim 7. Therefore, the arguments regarding the patentability of claim 7 are applicable to the patentability of claim 9. As well, the arguments regarding the patentability of claim 1 are applicable to the patentability of claim 9. Moreover, Armstrong adds no additional teaching or suggestion that would render claim 9 obvious. While Armstrong provides a system for directory assistance call completion via a mobile system (that is naturally wireless), nothing in Armstrong alone or in combination with Bendixen provides or makes obvious the present system as recited in claim 9.

2. Conclusion

In view of the above, a prima facie case of obviousness under 35 U.S.C. § 103 has not been established with regard to the invention of independent claim 9. Accordingly, withdrawal of the rejection, reconsideration and allowance of Applicant's claim 9 is hereby respectfully requested.

IV. 35 U.S.C. § 103(a) Rejection of Claim 10 (Bendixen et al.)

Claim 10 was rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,890,315 issued to Bendixen et al. Reconsideration of claim 10 is respectfully requested.

A. Fourth Claim Grouping: Claim 10

Discussion re: Patentability of Claim 10

1. Discussion

Claim 10 is dependent upon independent claim 7. Therefore, the arguments regarding the patentability of claim 7 are applicable to the patentability of claim 10. Adding a second telephone system interface for a second telephone handset is not obvious for the same reasons that a first telephone system for a first telephone handset is not obvious in view of Bendixen.

2. Conclusion

In view of the above, a prima facie case of obviousness under 35 U.S.C. § 103 has not been established with regard to the invention of independent claim 10. Accordingly, withdrawal of the rejection, reconsideration and allowance of Applicant's claim 10 is hereby respectfully requested.

(9) CONCLUSION

In view of the above, it is respectfully submitted that claims 7, 8 and 12-17 are not unpatentable under 35 U.S.C. §102 (b) as being anticipated by Bendixen et al (U.S. Patent 4,890,315).

In view of the above, it is respectfully submitted that claims 1-6 are not unpatentable under 35 U.S.C. §103(a) as being obvious over Bendixen et al. (U.S. Patent 4,890,315).

In view of the above, it is respectfully submitted that claim 9 is not unpatentable under 35 U.S.C. §103(a) as being obvious over Bendixen et al. (U.S. Patent 4,890,315) in view of Armstrong et al. (U.S. Patent 5,339,352).

Whether claim 10 is unpatentable under 35 U.S.C. §103(a) as being obvious over Bendixen et al. (U.S. Patent 4,890,315).

Thus, the Board of Appeals is respectfully requested to reverse the rejection of these claims.

Respectfully submitted,



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April 30, 2002

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(10) APPENDIX

1. A phone system adapter box for use with a phone system controller coupled to a telephone line that is operable to provide a telephony feature, said phone system adapter box, comprising:

a switch circuit operable to selectively couple a telephone to said telephone line;

a wireless communication interface operable to establish a wireless control channel between said wireless communication interface and said phone system controller, said wireless control channel operable to carry control signals associated with said telephony feature between said wireless communication interface and said phone system controller; and

a housing operable to house said switch circuit and said wireless communication interface.

2. The phone system adaptor box of claim 1, wherein:

said switch circuit is further operable to selectively couple said telephone to said wireless communication interface.

3. The phone system adaptor box of claim 1, wherein:

said wireless communication interface is further operable to establish a wireless communication channel between said wireless communication interface and said phone system controller, said wireless communication channel

operable to carry audio signals between said telephone and said phone system controller.

4. The phone system adaptor box of claim 1, wherein:

 said wireless communication interface is further operable to establish a wireless communication channel between said wireless communication interface and said phone system controller, said communication channel operable to carry dialing signals from said telephone to said phone system controller.

5. The phone system adaptor box of claim 1, wherein:

 said switch circuit couples said telephone to said telephone line in response to receiving a second control signal from said phone system controller via said wireless control channel.

6. The phone system adaptor box of claim 1, wherein:

 said wireless communication interface is further operable to establish a wireless communication channel between said wireless communication interface and a second phone system adaptor box, said wireless communication channel operable to carry audio signals between said wireless communication interface and said second phone system adaptor box.

7. A telephone system for providing a telephony feature, comprising a phone system controller and a first telephone system interface, wherein:

said first telephone system interface is coupled between a first telephone handset and a telephone line, said first telephone system interface operable to (i) selectively couple said first telephone handset to said telephone line, and (ii) establish a first wireless control channel to said phone system controller,

said wireless control channel operable to carry control signals associated with said telephony feature between said first telephone system interface and said phone system controller, and

said phone system controller is coupled to said telephone line and operable to (i) receive said first control signals via said wireless control channel, and (ii) process said first control signals to provide said telephony feature.

8. The telephone system of claim 7, wherein:

said first telephone system interface is further operable to establish a first wireless communication channel to said phone system controller, and

said wireless communication channel is operable to carry voice signals between said first telephone handset and said phone system controller.

9. The telephone system of claim 8, wherein:

said phone system controller is further operable to (i) process said voice signals received via said first wireless communication channel to obtain a

telephone number, and (ii) dial said telephone number by applying signals to said telephone line.

10. The telephone system of claim 7, further comprising a second telephone system interface coupled between a second telephone handset and said telephone line, wherein:

said second telephone system interface is operable to (i) selectively couple said second telephone handset to said telephone line, (ii) receive said control signals of said wireless control channel, and (iii) process said control signals in accordance with said telephony feature.

12. The telephone system of claim 7, wherein:

said first telephone system interface couples said first telephone handset to said telephone line in response to receiving a second control signal from said phone system controller via said wireless control channel.

13. A method of connecting a telephone to a phone system controller coupled to a telephone line that provides a telephony feature, comprising the steps of:

establishing a wireless control channel between said phone system controller and a phone system adapter box coupled to said telephone line and said telephone;

transmitting control signals associated with a telephony feature from said phone system controller to said phone system adaptor box via said wireless control channel; and

processing said control signals at said phone system adaptor box in order to provide said telephony feature.

14. The method of claim 13, wherein said processing step comprises the step of:

providing said telephony feature by said phone system controller applying signals to said telephone line to which said phone system adapter box is coupled.

15. The method of claim 13, further comprising the steps of (i) establishing a wireless communications channel between said phone system controller and said phone system adaptor box and (ii) transmitting voice signals to said phone system controller via said wireless communications channel, wherein:

said processing step includes the step of processing said voice signals in order to provide said telephony feature.

16. The method of claim 13, further comprising the steps of (i) establishing a wireless communications channel between said phone system controller and said phone system adaptor box; and (ii) transmitting dialing signals to said phone system controller via said wireless communications channel, wherein:

said processing step includes the step of processing said dialing signals in order to provide said telephony feature.

17. The method of claim 13, wherein said processing step includes the step of transmitting from said phone system controller a second control signal over said wireless control channel and, further comprising the step of:

coupling said telephone to said telephone line in response to said second control signal being received by said phone system adapter box.